

### **Remarks**

Applicants have herein canceled claims 1-20, without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter encompassed by all canceled claims in one or more divisional or continuation applications. Support for new 21-34 can be found in the specification at, for example, pages 35-36. Thus, no new matter has been added. Upon entry of the present amendments, claims 21-34 will be pending.

### **Election by Originally Presented Claims**

The Examiner has issued a restriction requirement separating pending claims 1-20 into ten groups. In response to the restriction requirement, Applicants hereby elect the subject matter of new claims 21-34 under the provision of M.P.E.P. (8<sup>th</sup> edition, revision 2) § 818.02(a), Election by Presentation of Original Claims, which provides:

Where claims to another invention are properly added and entered in the application before an action is given, they are treated as original claims for purposes of restriction only.

Applicants respectfully submit that that the "office action" referred to in M.P.E.P. § 818.02(a) is an office action on the merits, not merely a restriction requirement. This interpretation is supported by M.P.E.P. sections 818.01 (which indicates that election is fixed by an office action on their merits), 818.02(a) second paragraph (stating the election acted upon by the Office on their merits determine the invention elected) and 821.03 (see reproduced form paragraph 8.04 which indicates that election by presentation of original claims is improper after an action on the merits). Thus, Applicants' respectfully submit that this election is responsive.

### **Provisional Election with Traverse**

In the event that the Patent Office maintains that a complete reply to a restriction requirement must contain an election of one of the groups cast by the Examiner even when Applicants make an election by presentation of original claims pursuant to M.P.E.P. § 818.02(a), Applicants hereby provisionally elect Group III, *with traverse*, claims 25, 30 and 34, directed towards antibodies, as cast by the Examiner, with an earnest request that the Examiner reconsider the Restriction Requirement and allow Applicants to prosecute

the subject matter of new claims 21-34, which are drawn to a methods of making antibodies.

With respect to the restriction of original claims 1-20 into ten groups, Applicants maintain that the restriction is improper unless it can be shown that the search and examination of all groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, no such showing has been made. At the very least, a search of the elected claims would provide useful information for the claims in other related groups. For example, a search of antibodies that are produced by immunizing an animal with a protein encoded by ATCC Deposit 75824 would inherently provide relevant information on the protein used to immunize the animal and nucleic acids encoding that protein.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

### **Conclusion**

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the instant application. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to our Deposit Account.

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Respectfully submitted,

By 

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